

MAY 02 2007

Response Under 37 C.F.R. § 1.116 - Expedited Examining Procedure

Page 2 of 8

Serial No.: 10/758,626

Confirmation No.: 6109

Filed: January 15, 2004

For: RESEALABLE CONTAINERS HAVING INTERNAL ROLLER SURFACE

Remarks

The Final Office Action of February 20, 2007 has been received and reviewed. With no claims having been amended, canceled, or added, the pending claims remain claims 1-7, 10, 12-30, 32, 33, and 35-39 (of which claims 17 and 23-25 are withdrawn from consideration). Reconsideration and withdrawal of the rejections are respectfully requested for at least the reasons set forth below.

The 35 U.S.C. § 102 Rejection

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

M.P.E.P. § 2131 (citation omitted).

Claims 30, 35, 38, and 39 were rejected under 35 U.S.C. § 102(b) as being anticipated by Jaeger (U.S. Pat. App. Pub. No. 2001/0050284). Applicants respectfully traverse this rejection.

Jaeger recites a bin, i.e., waste barrel, for collecting biological materials. As shown in the unnumbered figure, the bin may include a bottom grating 12 near the bottom of the bin. See Jaeger, paragraph 27.

Applicants submit that no teaching is identified within the disclosure of Jaeger of a container including each and every recitation found in independent claims 30 and 38 (from which claims 35 and 39 respectively depend) as required for anticipation.

For example, claim 30 recites, *inter alia*, a container body defining a partially enclosed reservoir having an open top, the reservoir operable to hold a designated volume of liquid, and a first roller surface pivotally coupled to the container body. Similarly, claim 38 recites, among other elements, a container body having a floor and at least one pair of opposing sidewalls, the floor and the at least one pair of opposing sidewalls defining a reservoir operable to hold a designated volume of liquid, and a first roller surface pivotally coupled to the at least one pair of opposing sidewalls.

While no clear reference is made in the Office Action as to what equates to the claimed reservoir, the only portion of the barrel 1 that appears capable of defining a reservoir operable to

Response Under 37 C.F.R. § 1.116 - Expedited Examining Procedure

Page 3 of 8

Serial No.: 10/758,626

Confirmation No.: 6109

Filed: January 15, 2004

For: RESEALABLE CONTAINERS HAVING INTERNAL ROLLER SURFACE

hold a designated volume of liquid would be the bottom 3 and the sidewalls 2. The Final Office Action does indicate, however, that it equates the grating 12 to the claimed roller surface. See *Final Office Action*, Feb. 20, 2007, page 2.

Applicants submit that, among other deficiencies, the grating 12 of Jaeger is not pivotally coupled to the container body or sidewalls of the barrel 1 as recited by claims 30 and 38, respectively, but is rather attached to annular side gratings 10. See *Jaeger*, paragraph 27. Stated another way, the rejected claims recite that the roller surface is pivotally coupled to either the container body or the opposing sidewalls of the container body. The side gratings 10 of Jaeger (to which the bottom grating 12 is attached), on the other hand, clearly do not form the container body or sidewalls thereof as claimed, e.g., the side gratings are not operable to hold a designated volume of liquid as they contain vertical slots 11. See *Jaeger*, paragraph 26.

Moreover, the Final Office Action asserts that the "top surface of the grating 12 is inherently capable of allowing a paint roller to be rolled on this surface." *Final Office Action*, Feb. 20, 2007, page 2.

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. . . "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."

M.P.E.P. § 2112(IV) (citing *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999) (other citations omitted)).

Nothing is identified, nor is any extrinsic evidence presented, that shows that a paint roller could be rolled on the grating 12 of Jaeger. In fact, it appears unlikely that grating 12 could be utilized as a paint roller surface because the grating 12 resides at the bottom of a deep barrel, a location which would be difficult, if even realistically possible, to reach.

For at least the above reasons, Applicants respectfully submit that claims 30 and 38 are not anticipated by Jaeger. With respect to dependent claims 35 and 39, each of which depends

Response Under 37 C.F.R. § 1.116 - Expedited Examining Procedure

Page 4 of 8

Serial No.: 10/758,626

Confirmation No.: 6109

Filed: January 15, 2004

For: RESEALABLE CONTAINERS HAVING INTERNAL ROLLER SURFACE

from either independent claim 30 or 38, Applicants submit that such claims are also novel over Jaeger for the same reasons presented above. Moreover, such claims recite additional elements that further support patentability.

Reconsideration and withdrawal of this rejection are requested.

The 35 U.S.C. § 103 Rejections

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. M.P.E.P. § 2143.

Claims 1-3, 6, 7, 10, 12-15, 19, 20, 30, 32, and 35-39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Drum (U.S. Pat. No. 2,659,917) in view of Jaeger.

Claims 4, 5, 16, 18, and 33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Drum in view of Jaeger and further in view of Stern et al. (U.S. Pat. No. 6,102,235).

Claims 21 and 22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Drum in view of Jaeger and further in view of Carling et al. (U.S. Pat. No. 5,992,106).

Claims 26-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Giarrante (U.S. Pat. No. 5,893,489) in view of Stern et al.

Applicants respectfully traverse these rejections for at least the reasons set forth below.

- **Claims 1-3, 6, 7, 10, 12-15, 19, 20, 30, 32, and 35-39 (Drum in view of Jaeger)**

Applicants submit that there is no motivation or suggestion identified to combine the teachings of Drum with those of Jaeger and, even if such a motivation or suggestion were to exist, it is beyond any predicable use of the combined respective elements of these two documents.

For example, Drum discloses a paint tray to be used with a paint roller. Jaeger, on the other hand, discloses a bin, e.g., waste barrel having sidewalls 2 and perforated side grates (slots

Response Under 37 C.F.R. § 1.116 - Expedited Examining Procedure

Page 5 of 8

Serial No.: 10/758,626

Confirmation No.: 6109

Filed: January 15, 2004

For: RESEALABLE CONTAINERS HAVING INTERNAL ROLLER SURFACE

11), for collecting biological materials. It is unclear why one of skill in the art of paint trays would be motivated to look to the non-analogous art of waste bins. Moreover, even if such a person were aware of Jaeger, it is unclear what motivation exists to combine a grating located at the bottom of a deep waste bin into a paint tray such as that described by Drum as the grating would be difficult, if even realistically possible, to reach. *See Jaeger*, Unnumbered Figure. Still further, locating a suspended paint roller surface at the bottom of a paint roller tray, as would appear to be the alleged suggestion of Jaeger, would defeat the purpose of the roller surface as the grate would be submerged, at least until the paint volume became quite low. For at least these reasons, it is unclear why one of skill in the art would be motivated to combine the teachings of these two documents.

Further, Applicants submit that no expectation of success to modify Drum in view of Jaeger to meet the limitations of the rejected claims has been presented as required for *prima facie* obviousness. Jaeger discloses a waste barrel "which makes the relatively inexpensive collection of valuable biological materials possible." *Jaeger*, paragraph 9. It is unclear as to why one of skill in the art of paint trays would reasonably expect that modifying the paint tray of Drum with the grating 12 of Jaeger would result in a more effective paint tray.

Still further, it is submitted that Drum in view of Jaeger fails to teach or suggest each and every element of independent claims 1, 30, and 38. For instance, there is no teaching or suggestion identified in Jaeger of a roller surface pivotally coupled to sidewalls or to the container body (see anticipation remarks presented above regarding Jaeger). Nothing is identified within Drum that remedies this deficiency.

Applicants submit that claims 1-3, 6, 7, 10, 12-15, 19, 20, 30, 32, and 35-39 are nonobvious over Drum in view of Jaeger for at least the reasons set forth above. These claims also recite additional elements that further support patentability (see, e.g., claims 12-15). Reconsideration and withdrawal of this rejection are, therefore, requested.

- Claims 4, 5, 16, 18, and 33 (Drum in view of Jaeger and further in view of Stern et al.)

As stated above, it is submitted that the combination of Drum and Jaeger fails to establish *prima facie* obviousness with respect to claims 1 (from which claims 4, 5, 16, and 18 depend)

Response Under 37 C.F.R. § 1.116 - Expedited Examining Procedure

Page 6 of 8

Serial No.: 10/758,626

Confirmation No.: 6109

Filed: January 15, 2004

For: RESEALABLE CONTAINERS HAVING INTERNAL ROLLER SURFACE

and 30 (from which claim 33 depends), e.g., no identified suggestion or motivation to combine the teachings, no identified expectation of success. Nothing is identified within the disclosure of Stern et al. that remedies these deficiencies. Rather, Stern et al. is relied upon merely to teach a lid with an access opening and a handle. It is further unclear what motivation may exist to combine the teachings of Stern et al. with those of Drum and Jaeger.

For at least these reasons, Applicants submit that claims 4, 5, 16, 18, and 33 are nonobvious over Drum in view of Jaeger and further in view of Stern et al. Reconsideration and withdrawal of this rejection are, therefore, requested.

- Claims 21 and 22 (Drum in view of Jaeger and further in view of Carling et al.)

As stated above, it is submitted that the combination of Drum and Jaeger fails to establish *prima facie* obviousness with respect to claim 1 (from which claims 21 and 22 depend), e.g., no identified suggestion or motivation to combine the teachings, no identified expectation of success. Nothing is identified within the disclosure of Carling et al. that remedies these deficiencies. Rather, Carling et al. is relied upon to teach an "X-shaped support structure."

Furthermore, Carling et al. is directed to a floor covering tile having a honeycomb wall structure. It is unclear what motivation exists to combine the teachings of floor covering art with either a paint tray (Drum) or a waste bin (Jaeger). Also, it is unclear what portion of Carling et al. is even relied upon to teach the recited X-shaped support structure of claim 22.

For at least these reasons, Applicants respectfully submit that claims 21 and 22 are nonobvious over Drum in view of Jaeger and further in view of Carling et al. Reconsideration and withdrawal of this rejection are, therefore, requested.

- Claims 26-29 (Giarrante in view of Stern et al.)

It is noted that this rejection is maintained from the first Office Action, yet Applicants remarks provided in the response of January 26, 2007 have not been addressed. It is believed that these previously-provided comments are sufficient to overcome the rejection and, as a result, portions are repeated herein. In the event the Examiner maintains this rejection, a detailed response to Applicants' remarks is respectfully requested.

Response Under 37 C.F.R. § 1.116 - Expedited Examining Procedure

Page 7 of 8

Serial No.: 10/758,626

Confirmation No.: 6109

Filed: January 15, 2004

For: RESEALABLE CONTAINERS HAVING INTERNAL ROLLER SURFACE

Applicants submit that Giarrante in view of Stern et al. does not teach, or even suggest, all the recitations of claims 26-29 as required to establish *prima facie* obviousness. For example, there is no information identified in either document that teaches or suggests a container including, *inter alia*, a container body, a removable lid, and a first roller surface coupled to the container body as recited in claim 26. The shelf 33 of Giarrante, which the Final Office Action indicates as equivalent to the first roller surface, is fixedly attached to the removable base member 22 of the cover 21 and not to the container body. *Giarrante*, Figures 1 and 5. Nothing is identified within the disclosure of Stern et al. that remedies this deficiency. Therefore, the combination of Giarrante and Stern et al., as identified by the Office Action, does not teach or suggest an article as recited in claim 26.

Further, nothing is identified within Giarrante and Stern et al., either alone or in combination, that teaches or suggests a container wherein a first roller surface is positioned between two or more sidewalls, and wherein the first roller surface is, when in a first position, located above the designated volume of liquid and below an uppermost edge of the container body. Rather, it appears from the illustrations (*see, e.g.*, *Giarrante*, Figures 1 and 5, *Stern et al.*, Figures 3, 8, and 19) that the equivalent roller surfaces of Giarrante and Stern et al. are at least partially above the sidewalls and the uppermost edge of the container.

Yet further, Applicants submit that any motivation or suggestion to modify Giarrante in view of Stern et al. to meet the limitations of the rejected claims is lacking. In fact, it is submitted that the two documents teach away from combination. For instance, Stern et al. indicates that one objective of its design is to provide a lid that "has a planar top surface allowing it to be stacked with other paint-filled containers without the possibility of damage to the lid." *Stern et al.*, column 2, lines 64-67. *Giarrante*, on the other hand, has a lid that would appear to generally interfere with such stacking. *See Giarrante*, Figure 1. For these and other reasons, it is unclear why one of skill in the art would be motivated to combine the teachings of these two documents.

MAY 02 2007

Response Under 37 C.F.R. § 1.116 - Expedited Examining Procedure

Page 8 of 8

Serial No.: 10/758,626

Confirmation No.: 6109

Filed: January 15, 2004

For: RESEALABLE CONTAINERS HAVING INTERNAL ROLLER SURFACE

Applicants respectfully submit that claim 26 is nonobvious over Giarrante in view of Stern et al. for at least the reasons set forth above. Claims 27-29 are also submitted to be allowable not only because of their dependence, but also because of the particular subject matter recited therein (see, e.g., sloped portion of claim 29). Reconsideration and withdrawal of this rejection are, therefore, requested.

Summary

It is submitted that the pending claims are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted

By

Mueeting, Raasch & Gebhardt, P.A.

P.O. Box 581415

Minneapolis, MN 55458-1415

Phone: (612) 305-1220

Facsimile: (612) 305-1228

Customer Number 26813

2 May 2007
DateBy: Matthew W. Adams
Matthew W. Adams
Reg. No. 43,459
Direct Dial (612) 305-1227CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that this paper is being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 2nd day of May, 2007, at 3:52 pm (Central Time).

By: Danielle MorozName: Danielle Moroz